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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): O. YOKOMIZO, et al

Serial No.: 08/470,424

Filed: June 6, 1995

For: FUEL ASSEMBLY AND NUCLEAR REACTOR

Group: 2204

Examiner: H. Behrend

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GROUP 2200

PETITION FOR COMPLETE OFFICE ACTION

Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

July 30, 1996

Sir:

Petitioners, through their undersigned attorney,  
respectfully petition the Commissioner of Patents and  
Trademarks to require the Examiner to issue a complete Office  
Action in this application, including an action with respect  
to claims 24-29 for the following reasons.

In the Office Action dated July 5, 1996, the Examiner has  
withdrawn claims 24-29 from consideration as being directed to  
an invention that is independent or distinct from the  
invention originally presented, and originally elected in the  
3/29/96 Response.

In section 1 at pages 2 and 3 of the Office Action, the  
Examiner sets forth essentially the following items:

(1) The originally presented invention as set forth in original claims 1-23 is to an apparatus;

(2) The 2/29/96 Office action set forth a requirement of election of species of said apparatus;

(3) Applicant in the paper filed 3/29/96, responded to said Office action by electing the species designated I, B;

(4) Newly submitted claims 24-29 are directed to a method;

(5) The invention set forth in the newly submitted claims 24-29 and the originally presented invention set forth in original claims 1-23 are related as process and apparatus for its practice and are restrictable in accordance with MPEP 806.05(e);

(6) Accordingly, the apparatus invention of original claims 1-23 has been constructively elected by original presentation of claims as well as by applicants specific election (in the 3/29/96 response) of species I, B of said apparatus claims for prosecution on the merits. Newly submitted claims 24-29 are accordingly withdrawn from further consideration as being drawn to a non-elected invention (see 37 CFR 1.142(b), 37 CFR 1.145 and MPEP 821.03.

Petitioners do not dispute items (1)-(4) as set forth by the Examiner, but submit that the Examiner has not set forth a restriction requirement to which applicants have had an opportunity to respond and that the withdrawal of claims 24-29 is improper and not in accordance with MPEP §821.03, it being noted that newly submitted claims 24-29 were submitted a

Supplemental Amendment filed June 14, 1996 which was filed prior to the July 5, 1996 issuance of an Office Action on the merits. Referring to MPEP §821.03 cited by the Examiner, Petitioners note that this portion of the Manual, provides that:

Claims added by amendment following action by the Examiner, MPEP §818.01, §818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145. (emphasis added)

Thus, one must look to MPEP §818.01 and §818.02(a). More particularly, MPEP §818.01 provides that "Election becomes fixed when the claims in an application have received an action on their merits by the Office". (emphasis added) Furthermore, MPEP §818.02(a) provides that "Where claims to another invention are properly added and entered in the case before an action is given, they are treated as original claims for purposes of restriction only. The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant, and subsequently presented claims to an invention other than that acted upon should be treated as provided in MPEP §821.03." (emphasis added)

Petitioners submit that in this application, claims 24-29 were submitted in the Supplemental Amendment of June 14, 1996, which was prior to the Office Action of July 5, 1996, such Office Action being the first action on the merits in this application. Accordingly, irrespective of the contentions by the Examiner, in accordance with MPEP §818.01 and §818.02(a),

claims 24-29 must be considered, since such claims were presented prior to an action on the merits in this application and the proper course of action is for the Examiner to issue an Office Action requiring restriction and/or election of species, as determined by the Examiner, with Petitioners being given an opportunity to properly respond thereto, it being noted that claims 24-29, although directed to a method rather than an apparatus, are considered to be readable on the elected species.

For the foregoing reasons, Petitioners request granting of this Petition and the requirement for the Examiner to issue a complete Office Action, including claims 24-29.

Respectfully submitted,

  
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